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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,986	09/05/2003	Noriyoshi Ueda	03500.014620.1	5648

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NEW YORK, NY 10112

EXAMINER
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FLORES SANCHEZ, OMAR

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 11/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/654,986	<b>Applicant(s)</b> UEDA ET AL.	
	<b>Examiner</b> Omar Flores-Sánchez	<b>Art Unit</b> 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 13-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. This action is in response to applicant's amendment received on 08/19/05.

#### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by Perrone (5,669,277).

Perrone discloses the invention substantially as claimed including a sheet punching device, die holes 44, a plurality of punch trains (Fig. 1 and 2), a plurality of punches 42, a first rotatable shaft 16 and a second rotatable shaft 18.

#### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 13-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perrone (5,669,277) in view of Okamoto et al. (6,386,080 B1).

Perrone discloses the invention substantially as claimed including a sheet punching device, die holes 44, a plurality of punch trains (Fig. 1 and 2), a plurality of punches 42, a first

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rotatable shaft 16 and a second rotatable shaft 18. Perrone does not show a plurality of initial position detecting sensors disposed in correspondence with the plurality of punch trains and a sheet end detecting sensor. However, Okamoto et al. teaches the use of an initial position detecting sensor 76 disposed in correspondence with a punch train and a sheet end detecting sensor 31 for the purpose of accurately punching the sheet at a predetermined position. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Perrone's device by providing the initial position detecting sensor disposed in correspondence with the punch train and the sheet end detecting sensor as taught by Okamoto et al. in order to obtain a device to accurately punch the sheet without stopping the sheet.

Regarding the plurality of sensors, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Perrone's device by providing the plurality of sensors disposed in correspondence with the plurality of punch trains for the purpose of controlling all the punch trains in order to accurately punching the sheet at a predetermined position, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

6. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perrone (5,669,277) in view of Okamoto et al. (6,386,080 B1).

Perrone discloses the invention substantially as claimed except for a initial position detecting sensors disposed in correspondence with the plurality of punch trains and a sheet end

detecting sensor. However, Okamoto et al. teaches the use of an initial position detecting sensor 76 disposed in correspondence with a punch train and a sheet end detecting sensor 31 for the purpose of accurately punching the sheet at a predetermined position. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Perrone's device by providing the initial position detecting sensor disposed in correspondence with the punch train and the sheet end detecting sensor as taught by Okamoto et al. in order to obtain a device to accurately punch the sheet without stopping the sheet.

#### ***Response to Arguments***

7. Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that Perrone does not show to "selectively use one train of the plurality of punch trains to cut holes in the sheet". However, Perrone teaches in Fig. 1 the use of one of the plurality of punch trains cutting holes 36 in the sheet 38. Also, Perrone discloses the desire of select any one the format for achieving registration can be found in the Abstract. Perrone shows selecting different punch trains to punch holes at different positions (see Fig. 1A). Since, Perrone discloses the desire to select any one format (the plurality of punch trains) Saitoh et al. does not need to disclose it to be combinable. Saitoh teaches the detecting sensor 71 and the sheet end detecting sensor 31 to set the initial position of one punch train similar to applicant's invention that use one sensor 562 to determine the initial position of one punch train.

***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

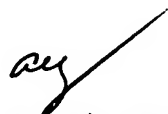
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar Flores-Sánchez whose telephone number is 571-272-4507. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 571-272-4514. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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11/14/05



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